



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/895,936 07/17/97 WISNEIEWSKI

R 17882706

EXAMINER

QM02/1219

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ART UNIT

PAPER NUMBER

3743

21

DATE MAILED:

12/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

see attached.

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Applicants' response of September 5, 2000 (Paper No. 20) including a copy of the 1992 Wisniewski and Wu prior art (Paper No. 19) has been received. Prior to that, declarations (4) under 37 C.F.R. 1.132 (Paper No. 17) and method-of-use claims (Paper No. 16) were filed on April 18, 2000. A supplemental amendment canceling claims 53, 54 and 66, amending claim 47 and altering the specification was filed on December 8, 2000.

During an interview (on August 1, 2000) in a companion case (SN 08/895,782) counsel insisted that the notice of non-responsive amendment in the present file (Paper No. 18) was mailed in error by the examiner in view of an agreement between the examiner and counsel to permit a change of invention (i.e. from apparatus claims to method-of-use claims) mid-prosecution (see Paper No. 12).

The aforementioned permission to switch inventions from apparatus to method-of-use was given in Paper No. 12, but counsel, for reasons unknown to the examiner, failed to file method-of-use claims after the interview of June 14, 1999 (Paper No. 12) or in response to the restriction requirement (Paper No. 13) sent June 21, 1999. In Paper No. 13, page 2, third paragraph, the Examiner specifically reiterated the relevant case law that was discussed in the course of the interview (Paper No. 12) and copies of materials collected by the Examiner related to this issue were given to counsel during the interview as he seemed to be unaware of the pitfalls of apparatus claims in the present context.

In counsel's response (Paper No. 14) to the restriction requirement (Paper No. 13) and approximately five weeks after the interview (Paper No. 12), counsel had made no indication that

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applicants intended to prosecute method-of-use claims as suggested by the examiner. At that point, the undersigned, assuming his warnings had gone unheeded, proceeded to examine the existing apparatus claims and rejected them (Paper No. 15).

Ten months after the interview and intervening prosecution of apparatus claims, in Paper No. 16, counsel finally changed course and submitted an entirely new set of method-of-use claims. The Examiner considered this to be an untimely change of invention (see Paper No. 18), notwithstanding the agreement made in Paper No. 12, because of the exceedingly long delays and the intervening prosecution of apparatus claims (see Paper No. 13 and 15). Counsel argued to Mr. Lazarus (SPE 3743) during the August 1, 2000 interview in companion application SN 08/895,782 (where a seasonable change of invention had occurred) that the Examiner had agreed to the change from apparatus to method-of-use claims neglecting to mention the intervening prosecution of apparatus claims. The Examiner had every reason to believe that counsel was going to make the change in a reasonable amount of time and without requiring the examiner to generate superfluous office actions (i.e. Paper Nos. 13 & 15) related to apparatus claims that applicants (apparently) were going to cancel.

The PTO is committed to compact prosecution giving all applicants timely decisions. Waiting and letting the examiner rely to his detriment on inaction with respect to changing the invention in a timely manner does not contribute to the goals of compact prosecution. It delays other applications and it wastes examining time, an extremely precious commodity.

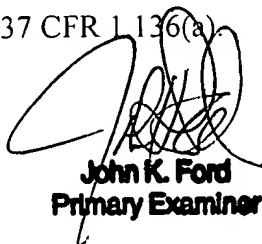
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Nevertheless, the examiner extends the courtesy of a change of invention at this late stage of prosecution because of counsel's apparent misunderstanding of his responsibility to make a seasonable change of invention and in an effort to resolve the outstanding issues.

Having permitted the change of invention, it does not appear that applicants have provided a listing of claims (pertaining to newly presented claims 36-68) readable on the elected species as required by MPEP 809.02(a): "To be complete, a reply to a requirement made according to this section should include a proper election along with a listing of all claims readable thereon, *including any claims subsequently added.*" (emphasis supplied).

The replies filed on December 8, 2000 and April 18, 2000 are not fully responsive to the prior Office action because of the following omission(s) or matter(s): no listing of which newly added claims (36 - 68) are readable on the elected species. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).



John K. Ford
Primary Examiner